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NOV 02 2004

OFFICE OF PETITIONS

In re Application of
Owens : DECISION REFUSING STATUS
Application No.: 10/815,608 : UNDER 37 CFR 1.47(b)
Filed: April 1, 2004 :
Attorney Docket No.: AVERP3538USA :
For: NEWSPRINT DISPENSING DEVICE :

This is a decision on the petition under 37 CFR 1.47(b), filed July 27, 2004 (certificate of mailing date July 22, 2004).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on April 1, 2004 without an executed oath or declaration. Accordingly, on June 17, 2004, a "Notice to File Missing Parts of Nonprovisional Application" (Notice) was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on July 27, 2004 (certificate of mailing date July 22, 2004), petitioner filed, *inter alia*, a declaration executed by Christian A. Simcic on behalf of Avery Dennison Corporation (Avery), a statement of facts by John W. Cornell, who attests that the non-signing inventor, John R. Owens, was an employee of Avery when the technology was developed, a copy of the employment agreement signed by Owens that establishes Owens was obligated to assign Avery the technology developed during his employment with Avery, proof of irreparable harm if the application is not prosecuted, the surcharge, authorization to charge the petition fee, and the instant petition.¹ A declaration of facts of Attorney Cynthia S. Murphy accompanies the petition. Attorney Murphy explains that she sent an assignment and combined declaration and power of attorney to Mr. Owens at his last known address and no response was received from Mr. Owens.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;
- (2) an acceptable oath or declaration;

¹ Pursuant to petitioner's authorization, deposit account no. 18-0988 will be charged the \$130.00 petition fee. The \$130.00 submitted with the instant petition was applied to the late declaration surcharge required by the June 17, 2004 Notice.

- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

This petition lacks items (1) and (2).

As to item (1), applicant has failed to establish that Mr. Owens has refused to sign the declaration or cannot be reached. A successful Rule 47 petition requires either (a) a clear refusal to join, whether expressly or by conduct, or (b) a showing of diligence in trying to find an unavailable inventor. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. A complete copy of the application, including specification, claims and drawings, and the declaration should be mailed to Mr. Owens' last known address with the request that Mr. Owens sign the declaration. MPEP 409.03(d) The statement of facts by Attorney Murphy does not establish that a complete copy of the application was mailed to Mr. Owens.

Mr. Owens must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. Mr. Owens cannot make the necessary statements found in the declaration-- i.e. "I have reviewed and understand..." -- without having examined the patent application.

Any written refusal should be included as documentary evidence in the reconsideration petition. If there is an oral refusal, the facts surrounding the refusal should be included in a declaration by a party with first hand knowledge of the refusal. If it is concluded by the 37 CFR 1.47 applicant that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration.

If petitioner alleges that Mr. Owens cannot be located, other attempts to reach Mr. Owen are required. If the papers are returned, and other efforts to locate the inventor, e.g. through e-mail or computer searches (such as LEXIS) continue to fail, then applicant will establish that the inventor cannot be reached.

Documentary evidence to support facts alleged in the affidavit or declaration should be submitted.

As to item(2), petitioner has not submitted a complete declaration. Petitioner has submitted an *added page* to a combined declaration and power of attorney, but there is no combined declaration and power of attorney present in the application file.

Petitioner is required to submit a declaration containing the required statements and information (37 CFR 1.63) and a newly executed added page to the declaration.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
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Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

By FAX: (703) 872-9306 – ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3230.



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Office of the Deputy Commissioner
for Patent Examination Policy